

REMARKS

I. Introduction

With the cancellation of claims 3, 4, 7 and 10, claims 1, 2, 5, 6, 8, 9 and 11 to 21 are pending in the present application. In view of the foregoing amendments and following remarks, it is respectfully submitted that claims 1, 2, 5, 6, 8, 9 and 11 to 21 are allowable and reconsideration is respectfully requested.

Applicants thank the Examiner for acknowledging the receipt of the information disclosure statement, form PTO 1449 and the references cited therein.

II. Rejection of Claims 3, 4 and 7 Under 35 U.S.C. § 112, Second Paragraph

Claims 3, 4 and 7 were rejected under 35 U.S.C. 112, second paragraph as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

The Office Action specifically notes that the feature "needle-like" in claims 3 and 4 is deemed vague and indefinite.

Applicants have cancelled claims 3, 4 and 7, without prejudice. Applicants respectfully request withdrawal of the rejection to claims 3, 4 and 7.

III. Rejection of Claims 1 to 21 Under 35 U.S.C. § 103(a)

Claims 1 to 21 were under 35 U.S.C. § 103(a) as unpatentable over United States Patent 2,875,543 ("Sylvester et al.") Applicants respectfully submit that Sylvester et al. do not render obvious claims 1 to 21 for the following reasons.

Claim 1 relates to a floor covering. Claim 1 comprises an elastomer material having a relief-type patterned surface, wherein the surface (2) is provided with irregularly distributed indentations (3), which have an elongated shape, which partially contact or intersect each other, and which have a depth (T) of 0.02 mm to 0.2 mm, at a width (B) of 0.2 mm to 2.5 mm and a length (L) of 5 mm to 50 mm. Claim 1 has been amended such that at least one end (6) of the indentations (3) is configured so as to run to a point. Support for the amendment may be found, for example, in originally filed claim 3.

The Office Action admits that Sylvester et al. fail to disclose the indentations being configured to run to a needle-like point. The Office Action notes that under some circumstances, changes in shape may impart patentability to a product if the particular shape claimed produces new and unexpected results which are different in kind and not mere in degree from the results of the prior art.

Applicants respectfully submit that Applicants have specifically provided such unexpected results wherein the present invention has an improved rolling resistance coefficient of friction compared to standard nap surfaces. A significant decrease in startup and rolling resistances is provided. Sliding friction measurements, however, are increased for surfaces with the present invention, counter to what would be expected from a mere change in surface texture. The present invention has the advantages of a smooth/planer surface with respect to sliding friction. A table of the unexpected results is provided on page 4 of the application. The present invention also provides a structure that is highly scuff resistant and which is easy to clean, while maintaining a significantly reduced rolling resistance, features that have not been present in one product to date.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, the combination of references does not disclose, or even suggest, all of the limitations of claim 1. It is therefore respectfully submitted that the combination of references does not render obvious claim 1.

Moreover, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the

Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to

provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” -- which is not the case here -- there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab’s invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

In view of the foregoing, it is respectfully submitted that the combination of the references does not render obvious claim 1.

Claims 3, 4, 7 and 10 have been cancelled, without prejudice, therefore the rejection is moot for these claims. Claims 2, 5, 6, 8, 9 and 11 to 21 ultimately depend from amended claim 1 and therefore include all of the features of amended claim 1. Applicants respectfully submit that claims 2, 5, 6, 8, 9 and 11 to 21 are patentable for at least the reasons presented in relation to claim 1. Applicants respectfully request withdrawal of the rejections to claims 2, 5, 6, 8, 9 and 11 to 21.

IV. Conclusion

It is therefore respectfully submitted that all pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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